

REMARKS

Entry of the foregoing, re-examination and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.112, and in light of the remarks which follow, are respectfully requested.

Claim 1 has been amended to include the recitation "fine particles in a non-aqueous dispersion medium, the fine particles being obtained by melting and kneading a coloring agent and a binder resin; and dispersing the coloring agent and binder resin in the non-aqueous medium". Support for the amendment may be found on pages 27-28 of the specification and in the working examples. Claim 2 has been amended in accordance with the Examiner's suggestion in paragraph (5) of the Official Action. Claim 5 has been canceled without prejudice or disclaimer. Claims 1-4 remain pending in this application.

Turning to the Office Action, claim 1 was provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of copending Application No. 10/668,158. Applicants traverse this rejection for the following reasons.

The present claims now specify that the compositions of the invention comprise fine particles dispersed in a non-aqueous medium, where the fine particles are obtained by melting and kneading a colorant and a binder resin. This feature is not set forth in the claims of the copending application.

Moreover, Applicants submit that mere overlapping in the scope of the respective claims is not, *per se*, double patenting. The present claims are directed to a patentably distinct invention from that claimed in Application No. 10/668,158.

For at least these reasons, the provisional obviousness double patenting rejection should be withdrawn. Such action is earnestly requested.

Claims 1-5 were rejected under 35 U.S.C. §112, second paragraph, for the reasons set forth in paragraph (5) of the Office Action. Claim 2 has been amended to recite proper Markush language, i.e., the phrase "the group consisting of" has been inserted in line 1 after formula (I).

In view of the above, the §112, second paragraph rejection has been obviated and should be withdrawn.

Claims 1-5 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Published Patent Application No. 2003/0232902 (Takahashi et al) for the reasons set forth in paragraph (7) of the Office Action. Claims 1-3 and 5 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,143,806 (Kato et al) for the reasons set forth in paragraph (8) of the Official Action. Claims 1, 2 and 5 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Published Patent Application No. 2002/0128349 (Qian et al) for the reasons discussed in paragraph (9) of the Official Action. Claims 1-3 and 5 were rejected under 35 U.S.C. §102(b) as being anticipated by Japanese Patent Document No. 11-286636 for (JP '636) the reasons set forth in paragraph (10) of the Office Action.. Reconsideration and withdrawal of these rejections are requested for at least the following reasons.

Publication No. 2003/0232902 (Takahashi et al) has a U.S. filing date of December 18, 2002, which is subsequent to the filing date of Applicants' priority application, i.e., Japanese Application No. 2002-282942, filed September 27, 2002. A certified copy of the Japanese Application and a sworn translation thereof are attached to the present amendment. The translation shows that the present claims are fully supported by the disclosure of the Japanese Application. Accordingly, with §102(e) rejection over the '902 published application should be withdrawn.

Kato et al '806 does not disclose compositions containing fine particles dispersed in a non-aqueous medium, where the fine particles are prepared by melting and kneading a coloring agent and a binder resin. As such, the document does not anticipate claims 1-4.

Qian et al '349 (published U.S. Application No. 2002/0128349) likewise fails to disclose the presently claimed feature of fine particles dispersed in a non-aqueous medium, where the particles are prepared by melting and kneading a colorant and a binder resin. As such, the document is not an anticipation of amended claims 1-4.

JP 11-286636 (Zebra Pen Corp.) also does not disclose a composition containing fine particles prepared by melting and kneading a colorant and a binder resin. Accordingly, JP '636 does not anticipate amended claims 1-4.

In view of the above, the §102(b) and §102(e) rejections should be withdrawn. Such action is earnestly solicited.

Claim 4 has been rejected under 35 U.S.C. §103(a) as obvious over Kato et al '806 or Qian et al '349, either in view of U.S. Patent No. 5,814,685 (Satake et al) for the reasons set forth in paragraph (13) of the Official Action. Claim 4 has also been rejected under 35 U.S.C. §103(a) as being obvious over Kato et al '806 or Qian et al '349, either in view of U.S. Published Patent Application No. 2003/0202089 (Horie et al) and U.S. Patent No. 5,942,560 (Idogawa et al), for the reasons given in paragraph (14) of the Office Action..

Reconsideration and withdrawal of these rejections are requested for at least the following reasons.

Satake et al '685 does not disclose the claimed feature of fine particles dispersed in a non-aqueous medium, where the fine particles are prepared by melting and kneading a coloring agent and a binder resin. Accordingly, the combined teachings of Kato et al '806 or Qian et al '349 with Satake et al '685 fails to disclose or suggest this feature. Moreover, while

Kato et al '806 and Qian et al '349 are directed to the use of non-aqueous dispersing media, Satake et al '685 is directed solely to aqueous dispersions. Those of ordinary skill would not have been motivated to apply the disclosure of Satake et al '685 to modify the non-aqueous dispersions of Kati et al '806 or Qian et al '349 nor would there have been a reasonable expectation that the modification would have been successful.

Published U.S. Application No. 2003/0202080 to Horie et al has a U.S. filing date of April 10, 2003 which is subsequent to the September 27, 2002 filing date of Applicants' Japanese priority application. In view of the certified copy and translation of the priority application submitted herewith, Horie et al '080 has been antedated.

In view of the above, the §103 rejections over Kato '806, Qian et al '349, Satake et al '695, Horie et al '089 and Idogawa et al '560 should be withdrawn. Such action is earnestly solicited.

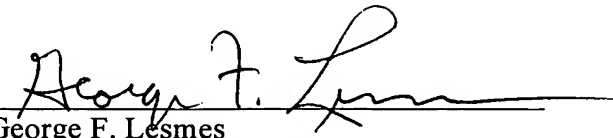
From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned at (703) 838-6683 at her earliest convenience.

Respectfully submitted,

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